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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/369,570	08/06/1999	MARCELLO TONCELLI	DRAGO-P86-RE	6991

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LACKENBACH SIEGAL
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SCARSDALE, NY 10583

EXAMINER

AFTERGUT, JEFF H

ART UNIT	PAPER NUMBER
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1733

DATE MAILED: 11/25/2002

25

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/369,570

Applicant(s)

TONCELLI, MARCELLO

Examiner

Jeff H. Aftergut

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 October 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 39-65 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 39-65 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____. 6) ☐ Other: _____

Claim Rejections - 35 USC § 103

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 39-45 and 52-54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese Patent 6-64076 in view of Webster's II New Riverside University Dictionary (newly cited) and any one of Japanese Patent 4-231545 (newly cited) or PCT WO 91/09733 or French Patent 2429100.

Japanese Patent '076 taught the basic operation as claimed including the reinforcement of the backside of a smooth natural stone with resin impregnated fibers wherein the backside of the stone was free from grooves or recesses. The reference suggested that those skilled in the art would have applied a glass fiber or carbon fiber fabric layer 104 to the backside of the stone wherein disposed between the glass fiber fabric and the stone was a reinforcing layer formed of resin 6 and fibers 2 which made up reinforcing layer 102. The reference expressly stated that more reinforcement than resin would have been useful in the reinforcing layers. The applicant takes the position that the layer 102 formed from fibers 2 was formed of fibers that were twisted. Applicant's own translation of the reference to Japanese Patent '076 suggested that the filaments were converged with a converging agent or they were twisted (so that twisting is an alternative to a converging agent for retaining the fibers). That being said, the fibers 2 of layer 102 in Japanese Patent '076 are the reinforcing layer disposed between the layer of reinforcement which contains the non-twisted linear reinforcing elements and the slab of stone. More specifically layer 104 has been interpreted to be the layer of reinforcement which contains the linear non-twisted reinforcing elements. Applicant has defined this layer to be in the form of glass fibers contained

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in a matting (see claims 40 and 41. the reference to Japanese Patent '076 refers to layer 104 as being a fabric or cloth of glass fibers but never expressly states that the layer of fabric or glass cloth was a "matting").

"Matting" is defined in Webster's II New Riverside University Dictionary as "Coarsely woven fabric for covering floors". The reference to Japanese Patent '076 suggested that the fabric used was one which was woven of glass fibers but it did not expressly suggest that it was one which was "coarsely woven". However, in the art of reinforcing a stone slab with a fabric layer, it was known as evidenced by either one of Japanese Patent '545 or PCT '733 to provide a "matting" of woven glass fibers as the reinforcement material. More specifically, Japanese Patent '545 suggested that "coarse woven fabric of glass fibre" was used with a resin as reinforcement for a stone slab (see reinforcement of coarsely woven fabric 3 in resin layer 4 of the reference and the abstract of the disclosure of the reference provided both from the Japanese Patent Office and Derwent). The reference to French Patent '100 suggested that "glass fibre cloth or matting" was used as a reinforcing layer for the backside of a stone slab (suggesting that in the art of making a reinforced stone slab the use of cloth or matting were art recognized equivalents). Lastly, note that the reference to PCT '733 clearly expressed that the layer of reinforcement 5 disposed on the backside of the stone slab was a matting of glass fiber, see the abstract of the disclosure, page 5, lines 11-19, for example. Clearly, it would have been understood from a viewing of Japanese Patent '076 that one skilled in the art providing the reinforced backing material therein for the stone slab would have recognized that a suitable woven material made of glass fibers would have included a matting of coarsely woven glass fibers as such material were conventionally utilized in the art for reinforcing stone slabs as evidenced by any one of Japanese

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Patent 4-231545 (newly cited) or PCT WO 91/09733 or French Patent 2429100. The position of the Office is that a matting of coarsely woven glass fibers is the material that applicant is utilizing for the reinforcement of the stone slab which included the linear non-twisted fiber reinforcement. Because matting materials were known for the same purpose, it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ a matting for the reinforcing layer 104 of Japanese Patent '076 as a matting layer was defined as a coarsely woven fabric (as evidenced by Webster's II New Riverside University Dictionary) and such mattings were known woven fabric useful for supporting a stone slab in combination with resin impregnating the same as suggested by any one of Japanese Patent 4-231545 (newly cited) or PCT WO 91/09733 or French Patent 2429100.

With regard to claim 40, the reference to Japanese Patent '076 suggested that the layer 104 included fibers of the fabric 4 which were either glass or carbon. With respect to claim 41, the reference to any one of Japanese Patent 4-231545 (newly cited) or PCT WO 91/09733 or French Patent 2429100 suggested that the matting would have been useful in the operation. Regarding claim 42, the reference to Japanese Patent '076 suggested the specified ratio of resin to reinforcement. Regarding claims 43 and 44, the reference to Japanese Patent '076 suggested stone slabs having the specified thicknesses. Regarding claim 45, note that Japanese Patent '076 suggested the use of stainless steel for the reinforcing fibers 2, see the translation, paragraph [0012] of the same. The applicant is advised (as discussed below in greater detail), the linear reinforcing elements of the disclosure were never referred to as being made of steel rather the reinforcing elements disposed between the matting and the slab (the reinforcement which was disposed within the grooves of the slab when such were provided) was formed of steel (see the

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112 rejection below). Regarding claim 52, note that the reference suggested the specified amount of resin to reinforcement. Regarding claim 53, note that Japanese Patent '076 suggested the use of slabs having the specified thicknesses. Regarding claim 54, the reference to Japanese Patent '076 clearly suggested the use of heating to harden the resin matrix, see paragraph [0025] of the reference.

3. Claims 58-64 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as set forth above in paragraph 2 further taken with Japanese Patent 63-242984 (newly cited).

The references as set forth above in paragraph 2 suggested the application of a single layer of matting against the backside of a slab for the reinforcement of the same (wherein the matting was taken to be made of fibers of glass which were non-twisted linear reinforcing members). The references, however, did not suggest that one skilled in the art at the time the invention was made would have incorporated a plurality of woven fabric layers for the backing of the stone slab to reinforce the same. However, the use of multiple fabric layers for reinforcing a stone slab such that the stone slab was allowed to be formed to be thin was known as evidenced by Japanese Patent '984. More specifically, Japanese Patent '984 suggested the use of a single layer of fabric for backing the stone slab as envisioned in Figure 1 where the slab 1 was reinforced with a fabric 2 and a resin impregnated into the same 3 or the use of plural layers of woven fabric 5 which were likewise impregnated with a resin and disposed on the backside of a smooth flat stone slab 1, see Figure 2. Clearly, depending upon the strength of the reinforcing matting as well as the demands of the needed strength of the reinforcement applied, it would have been obvious to one of ordinary skill in the art at the time the invention was made to

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provide plural matting layers against the backside of the stone panel as suggested by Japanese Patent '984 wherein the materials of the matting would have included the specified glass fiber matting as described above in paragraph 2.

Note that the specifics of the amount of resin used, the types of fibers used for the matting, as well as the types of resins employed, the reference to Japanese Patent '076 discussed above suggested the same.

4. Claims 46-51, 55-57 and 65 are rejected under 35 U.S.C. 103(a) as being unpatentable over E.P. 631,015 in view of E.P. 623,714 further taken with Japanese Patent 6-64076 in view of Webster's II New Riverside University Dictionary (newly cited) and any one of Japanese Patent 4-231545 (newly cited) or PCT WO 91/09733 (newly cited) or French Patent 2429100 (newly cited).

E.P. '015 and E.P. '714 are discussed at length in paper no. 19, paragraph 7. The references suggested that one skilled in the art would have provided reinforcing members of steel in grooves of the backside of a stone slab and additionally provided an additional layer of reinforcing material against such an arrangement. The references failed to make mention of the use of matting as the reinforcing layer of material applied to the backside of the stone (for the layer of reinforcement 52 in E.P. '714). However, as addressed above in paragraph 2, Japanese Patent '076 suggested that woven fabrics would have been impregnated with resin in the specified amounts and used as a reinforcement for the finished assembly. Certainly, the use of matting for the fabrics was well established as evidenced by Webster's II New Riverside University Dictionary (newly cited) and any one of Japanese Patent 4-231545 (newly cited) or PCT WO 91/09733 or French Patent 2429100 as discussed above. The Japanese Patent '076

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additionally expressly suggested that one would have provided unidirectionally disposed reinforcement against the slab between the slab and the matting layer, i.e. layer 102. The reinforcing layer 102 was formed of fibers which were steel or glass fibers. Note that the use of glass fiber instead of steel for the reinforcement in E.P. '015 disposed within the grooves would have therefore been an art recognized equivalent. While the reference did not expressly state what the dilation coefficient of the material was, one skilled in the art would have understood that the use of glass fiber with an epoxy resin would have had the same physical properties as that of the claimed invention.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 45-51, 55-57, and 61-65 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In each of claims 46-51 and 55-57, the applicant recites that grooves or recesses are formed or are present on the rear face of the slab which was reinforced, however claim 39 from which these claims depend recites that the stone slab was free of grooves or recesses. It appears that applicant is attempting to mix embodiments in the claim, however the rear face of the stone slab either has grooves or it doesn't have grooves. It is suggested that those claims which recite the presence of grooves be made into independent form as such claims are directed to a different species of invention from claim 39 which clearly envisioned the formation of a panel without the incorporation of grooves or recesses therein.

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In claim 45, the applicant is advised that it would appear that the reinforcing layer and not the linear reinforcing elements were formed of the steel. Namely, there is no description in the original disclosure of the use of the use of steel fibers for the matting of the claimed invention (the matting is defined to be formed of glass or carbon fibers). It is suggested that applicant change the claim to recite that the reinforcing layer is formed from steel rather than the linear reinforcing layer.

In claim 65, line 12, because the second layer of reinforcement is between the rear of the slab and the first layer of linear reinforcing elements, it would appear that the --second-- reinforcing layer and not the "first" reinforcing layer was disposed in the grooves or recesses. It is suggested that "first" be changed to --second-- in claim 65, line 12.

In claim 61 (a newly presented independent claim), the applicant recites that the rear face of the slab of stone material is "substantially free of grooves or recesses", however in the context of the disclosure there is no mention of what is meant by "substantially free" of the grooves or recesses, the surface is either free of grooves or recesses or it isn't. Because it is not known what the scope of the term "substantially" is, the exact scope of the claim cannot be ascertained. It should be noted that similar language appears in newly presented independent claim 65.

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claims 45 and 61-65 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed,

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had possession of the claimed invention. In claim 45, the applicant has recited that the linear reinforcing elements are formed of steel and metal, however the original disclosure only supports the use of steel reinforcing elements for those members which are disposed within grooves of the rear face of the slab. The original disclosure does not support forming the matting of metal fibers or steel fibers and such is deemed to be new matter. Additionally, in claim 65, the applicant recites on line 12 of the claim that the first reinforcement was disposed in the grooves or recesses, however there is no support in the original disclosure to support forcing both the first reinforcement and the second reinforcement into the grooves of the recesses (which would be the case since the first reinforcement was recited as being disposed outside the second reinforcement in the arrangement. In independent claims 61 and 65, the applicant recites that the surface of the slab is "substantially free of grooves or recesses". The original disclosure stated that the surface was free of grooves or recesses, but not that it was "substantially free". The exact amount of give associated with the term "substantially free" is not known and the exact scope of the language cannot be ascertained.

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Reissue Applications

9. Claims 61-65 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

In U.S. Patent 5,670,007 (of which this application is a reissue), the sole independent claim recited the following limitations:

“providing a slab of stone material having a rear **substantially smooth face** free of grooves or recess .”(emphasis added)

This is an “omitted limitation” in the independent claims in this application (09/369,570). More specifically, claims 61 and 65 as amended recite that the slab of stone is “substantially free of grooves or recesses”, while claim 65 additionally recites “forming grooves or recesses on the rear face of the slab”. “A reissue claim is broadened where some limitation of the patent is no longer in the reissue claim,” see MPEP 1412.02, page 1400-9, Rev. 2, Feb. 2000. The independent reissue claims have been broadened to omit the limitation relating to: (1) the

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exclusion of the substantially smooth face of the slab of stone (claims 65 and 61), and: (2) the inclusion of grooves or recesses in the rear face of the stone slab material (claim 65).

If the limitation now being omitted or broadened in the present reissue was originally presented/argued/stated in the original application to make the claims allowable over a rejection or objection made in the original application, the omitted limitation relates to subject matter previously surrendered by applicant, and impermissible recapture exists. " MPEP 1412.02, page 1400-9, Rev. 2, Feb 2000. the limitation regarding the substantially smooth face and the lack of grooves and recesses in the rear face were *presented* by appellant in the response dated 12-23-96 (a copy of which was made of record with the Examiner's Answer dated 2-23-01). The response was filed by appellant in an attempt to overcome a prior art rejection postulated by the examiner. these limitation were strenuously *argued* by applicant in the response dated 12-23-96 in the patented file where applicant argued that:

"Also emphasis has also been added to the claim to establish that it is a rear face of the stone slab material which is free from grooves or recesses, because as will be pointed out, this is another distinction from the prior art.", see page 5 of the response.

Additionally appellant is referred to page 7 of the response dated 12-23-96 where appellant argues that:

"Clearly, Toncelli '015 calls for the formation of grooves, and the placement of the rods in the grooves, and then the placement of resin into the grooves. Applicant starts out with a non-grooved surfaces, and creates the formation of areas between which the resin is inserted by calling for the provision of the non-twisted linear reinforcing elements on to a rear face of a slab of stone material having a rear face free of grooves or recesses. This clearly removes all of the references of record, because the main references has been removed, and therefore the modifying references have also been removed."

The appellant is additionally advised that in response to the amendment filed by appellant dated 12-23-96 the examiner allowed claims 1-6 and 8-21 and presented the following reasons for

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allowance in the patented file (to which there were no comments made by applicant in response to the same):

“None of the prior art of record teaches disposing a reinforcing layer between the linear reinforcing elements and the rear face of the slab of stone material (where rear face of the stone material was substantially smooth and free from grooves or recesses)”.

Clearly, the reason that the earlier claims were allowed was because the rear face of the stone slab was substantially smooth and free from grooves or recesses and there was a layer of reinforcing material between the linear non-twisted members and the rear face of the slab.

Hence, the above noted “omitted limitations” was originally *presented* and strenuously *argued* in the original application to render the claims allowable over a prior art rejection and the examiner’s reasons for allowance indicated that the “omitted limitations” distinguished over the prior art. The above noted omitted limitations therefore relate to subject matter previously surrendered in the original application.

“Reissue claims that are broader in certain aspects and narrower in other vis-à-vis claims canceled from the original application to obtain a patent may avoid the effect of the recapture rule if the claims are broader in a way that does not attempt to reclaim what was surrendered earlier.” MPEP 1412.02 (REISSUE CLAIMS ARE BROADER IN SCOPE IN SOME ASPECTS, BUT NARROWER IN OTHERS). Also: “[i]f the reissue claim is as broad as or broader in an aspect germane to prior art rejection, but narrower in another aspect completely unrelated to the rejection, the recapture rule bars the claim”, *In re Clement*, supra at 1165. The independent reissue claim 1 is “narrower” in scope than the patented claim since the claim requires that there be a **layer** of non-twisted linear reinforcing elements **applied to the rear face of the slab** (emphasis added). These narrowing limitations, however are **not** at all related to the

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“omitted limitations” of an insertion of a layer of reinforcement between the coated non-twisted reinforcing elements and the rear face of the slab of stone material and the manner in which they defined over the prior art. Since the narrowing aspect is not related to the prior art rejection and not related to the subject matter surrendered in the original application, recapture exists and claims 1-6 and 14-20 are properly rejected under 35 USC 251. The independent reissue claim 21 is “narrower” in scope than the patented claim since the claim requires grooves into which linear reinforcing elements are inserted with the prescribed amount of resin therein, it requires that a layer of non-twisted linear reinforcing elements were applied to the rear face of the stone slab, and the hardening of the resin wherein two layers of liner reinforcing elements are associated with the rear of the stone slab. These added, narrowing limitations are not at all related to the “omitted limitation” of an insertion of a layer of reinforcement between the coated non-twisted reinforcing elements and the rear face of the slab and additionally are not related to the lack of grooves on the rear face of the slab which was substantially smooth. Since the narrowing aspect is not related to the prior art rejection and not related to the subject matter surrendered in the original application, recapture exists and claims 61-65 are properly rejected under 35 USC 251.

Double Patenting

10. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

11. Claims 39-45 and 52-54 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 3, and 11 of U.S. Patent No. 6,205,727 in view of Japanese Patent 6-64076, Webster's II New Riverside University Dictionary (newly cited) and any one of Japanese Patent 4-231545 (newly cited) or PCT WO 91/09733 (newly cited) or French Patent 2429100 (newly cited).

The reference to U.S. Patent '727 has been discussed at length in paper no. 19 and applicant is referred to the same for a complete discussion of the reference. The reference failed to teach that one skilled in the art would have utilized multiple reinforcements for the backside of the stone slab, however the use of multiple reinforcements for the stone slab were known in the art as evidenced by Japanese Patent '076 and applicant is referred to paragraph 2 above for a complete discussion of the same. Additionally, the references to Webster's II New Riverside University Dictionary and any one of Japanese Patent 4-231545 or PCT WO 91/09733 or French Patent 2429100 further evidenced that those skilled in the art at the time the invention was made would have employed matting for the reinforcement which included non-twisted linear reinforcement therein. It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the techniques of Japanese Patent '076 in the operation of U.S. Patent '727 in order to provide added reinforcement to the backside of the stone slab wherein the same included non-twisted linear reinforcement as suggested by Webster's II New Riverside University Dictionary and any one of Japanese Patent 4-231545, PCT WO 91/09733 or

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French Patent 2429100. applicant is referred to paragraph 2 above for a complete discussion of the secondary references as well as the dependent claims.

12. Claims 58-64 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 3, and 11 of U.S. Patent No. 6,205,727 in view of Japanese Patent 6-64076, Webster's II New Riverside University Dictionary (newly cited) and any one of Japanese Patent 4-231545 (newly cited) or PCT WO 91/09733 (newly cited) or French Patent 2429100 (newly cited) and Japanese Patent 63-242984 (newly cited). .

The applicant is referred to paragraph 11 above for a complete discussion of the references listed above as well as a statement of obviousness as to why one skilled in the art would have selected a single matting for the backing of the stone slab. The combination failed to make mention of the use of two coarse woven fabrics for the reinforcement of the stone slab, however the use of multiple reinforcements was known as evidenced by Japanese Patent '984. applicant is referred to paragraph 3 above for a complete discussion of Japanese Patent '984. it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ multiple layers of matting in order to attain the desired strength and stiffness to the finished panel assembly in the process of making a stone panel as suggested was known by Japanese Patent '984 in the operation of making a reinforced stone pane as taught by U.S. Patent '727 as modified by of Japanese Patent 6-64076, Webster's II New Riverside University Dictionary (newly cited) and any one of Japanese Patent 4-231545 (newly cited) or PCT WO 91/09733 (newly cited) or French Patent 2429100 (newly cited).

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Response to Arguments

13. Applicant's arguments with respect to claims 39-65 have been considered but are moot in view of the new ground(s) of rejection.

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The applicant argues that none of the prior art of record taught or suggested that one skilled in the art at the time the invention was made would have utilized reinforcement in the form of linear non-twisted reinforcement and focuses much attention upon layer 102 of Japanese Patent '076 which was made with reinforcement 2. the applicant is advised that in fact it is layer 104 of reinforcement which was formed from linear non-twisted reinforcement. The reinforcement in layer 104 was a woven fabric of glass fibers. The applicant's themselves employed a matting (which was defined to be a coarse woven fabric). The references to any one of Japanese Patent 4-231545 (newly cited) or PCT WO 91/09733 or French Patent 2429100 suggested that such matting was known as a fabric, woven reinforcement for the back of a stone slab. To utilize such reinforcement in Japanese Patent '076 would have been within the purview of the ordinary artisan and would have resulted in the inclusion of a layer in the reinforcement which included linear, non-twisted glass fibers therein. Applicant's arguments relating to the layer 102 and the fibers therein is not persuasive.

Regarding the double patenting rejection, the applicant is advised that the rejection has been maintained (and changed). The applicant is advised that a terminal disclaimer is required in order to maintain common ownership between the patents. The question of term extension does not come into play as applicant has pointed out, however maintaining common ownership between the patents is also a judicially created requirement and applicant is requested to submit a terminal disclaimer.

The use of multiple fabrics for reinforcing the stone slab was known as evidenced by Japanese Patent '984 and to provide the fabrics in the form of a glass fabric of coarse woven

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fibers (a matting) would have been within the purview of the ordinary artisan as such fabrics are typical of the prior art as evidenced by the references set forth above.

Conclusion

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

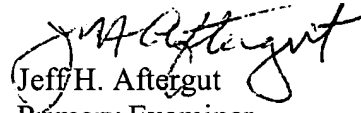
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeff H. Aftergut whose telephone number is 703-308-2069. The examiner can normally be reached on Monday-Friday 6:30-3:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael W. Ball can be reached on 703-308-2058. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.


Jeff H. Aftergut
Primary Examiner
Art Unit 1733

JHA
November 20, 2002